

### **REMARKS/ARGUMENTS**

This amendment is filed in response to the Office Action mailed March 21, 2006. In this Amendment, claims 1-6 and 8 are amended. Claim 7 has been cancelled. Following entry of this amendment, claims 1-6 and 8 shall be pending.

In the non-final Office Action, claims 1-8 have been rejected based on various grounds. The applicant hereby requests reconsideration of claims 1-6 and 8 in view of the amendments and reasons set forth below.

#### **I. REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH**

Claims 1-8 are rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has asserted that, "The instant claim 1 recites weight percentages of photochromic compounds and stabilizers, and that it is unclear what these percentages are based on, e.g. the entire composition, the resin, or some other basis." Applicant respectfully submits amended claim 1, which provides that the percentages by weight are in relation to the polyurethane film layer, and believes that any prior indefiniteness regarding claim 1 is no longer present. Therefore, Applicant respectfully requests that this rejection be withdrawn.

Further, the Examiner has asserted that, "The instant claim 2 does not end with a period. It is therefore unclear what else is required of the claim." Applicant has amended claim 2 accordingly to include a period, and submits that any prior indefiniteness is no longer present. Therefore, this rejection should be withdrawn.

Also, the Examiner has asserted that "The Markush groups of claim 2 are improper." Applicant has amended claim 2 to include "and" thereby putting the claim in proper form. Therefore, any prior indefiniteness regarding claim 2 is no longer present and Applicant respectfully requests that this rejection be withdrawn.

Lastly, the Examiner has asserted that, "It is unclear what is meant by – methyl(1,2,2,6,6-pentamethyl-4-piperidiny)sebacate. It is unclear if it is intended to be attached to the prior sebacate and if so how. Since only two HALS are allowed by the

claim, it is not seen that it can be a third independent moiety.” Applicant respectfully submits that, in fact, this cited element is intended to be attached to the prior sebacate. The element “-methyl(1,2,2,6,6-pentamethyl-4-piperidinyl)sebacate” as recited in claim 2 constitutes part of a commercially available blend of the prior sebacate and the “-methyl(1,2,2,...) component.” One example of such commercially available HALS is Tinuvin® 292 (sold by Ciba Speciality Chemicals, as disclosed in the specification of the present application). Therefore, the recited sebacate blend, as is illustrated by the commercial availability of this product, constitutes only one HALS per the allowable recited claim limitation. Applicant has amended claim 2, citing that this element of the claim comprises a sebacate “blend” and believes that claim 2 is no longer indefinite, such that the rejection should be withdrawn.

In view of the foregoing, it is submitted that any indefiniteness that may have existed in the claims is no longer present. Hence, withdrawal of all rejections under §112 is respectfully requested.

II. REJECTIONS UNDER 35 USC § 102(b) AS BEING ANTICIPATED BY U.S. PAT. APPLICATION PUB. NO. 2004/0207809 BLACKBURN ET AL. AND U.S. PAT. NO. 5,770,115 MISURA WHICH IS CITED IN BLACKBURN ET AL.

At paragraph 4 of the Office Action, Claims 1-2 and 4-8 were rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Application Pub. No. 2004/0207809 *Blackburn et al. et al.* and US Pat. No. 5,770,115 *Misura* which is cited in *Blackburn et al.*. The Examiner asserts that *Blackburn et al.* discloses photochromic coatings of polyurethane, the instantly claimed amount of photochromic compound, the instantly claimed thickness, and the instantly claimed stabilizer system having the instantly claimed amount of stabilizers. However, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In this regard, it is noted that the *Blackburn et al.* reference relates to a photochromic polymeric coating that is applied to a lens blank and/or rigid substrate. It is not related to the formation of a photochromic

film. Nor is it related to a laminated photochromic film as now recited in amended claim 1. Moreover, this distinction is not a trivial one.

For example, a photochromic film is typically characterized by a uniform cast resin substance that is made usually by depositing a photochromically-infused resin onto a sheet, evaporating or otherwise drying any solvent and/or liquid properties in the resin and thereafter removing and utilizing the resultant, dehydrated film either alone or by incorporation into, for example, a laminate component of an optical lens.

Such a photochromic film is entirely dissimilar from a coating as in *Blackburn et al.* insofar as a coating, by definition, must coat something. For example, the coating disclosed in *Blackburn et al.* is utilizable only in relation to the disclosed rigid substrate that it is being deposited on. In other words, a photochromic film may be used independently of a substrate, while a coating, by necessity, must include a substrate. As such, it cannot be suggested that *Blackburn et al.* anticipates the present claims and on this basis alone, withdrawal of the rejection is respectfully requested.

Given the deficiency of the *Blackburn et al.* reference as noted above, there is no proper basis for asserting the *Misura* reference in combination with *Blackburn et al.* in the first place. However, even if such a basis exists, *Misura* is also deficient. For example, the Examiner asserts that *Misura* discloses combinations of phenolic antioxidant and mixtures of two HALS for stabilizing polyurethanes, such that the change in b\* appears to be that of the instant claims. It is noted, however, that *Misura* also requires the use of a UV light absorber (see, e.g., Column 3, lines 33-47). This is contrary to the presently claimed invention in which the stabilizing system requires the absence of a UV light absorber. As with the distinctions noted with respect to *Blackburn et al.*, this distinction is also material, as noted below.

As is known in the art, UV absorbers block a portion of the UV rays that activate photochromic dyes. As a result, in *Misura* there is a need to increase the amount of photochromic dye incorporated into the solution so that the required photochromic effect is still achieved with the reduced amount of UV rays reaching the photochromic dye. This is highly undesirable given the high cost of photochromic dyes. And the presently

claimed invention avoids this problem insofar as the stabilizing system requires the absence of a UV light absorber. In summary, because *Misura* requires the use of a UV light absorber and the presently claimed invention requires an absence of UV light absorber, it is clear that *Misura* does not anticipate the present claims any more than does *Blackburn et al.* As such, withdrawal of this rejection is respectfully requested.

As to claims 2, 4-6 and 8, these claims depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

III. REJECTIONS UNDER 35 USC §103(A) AS BEING UNPATENTABLE OVER *BLACKBURN ET AL.* AND *MISURA* WHICH IS CITED IN *BLACKBURN ET AL.* IN VIEW OF US. PAT. NO. 6,113,813 *GOUDJIL* AND US PAT. NO. 4,962,013 *TATEOKA ET AL.*

At paragraph 5 of the Office Action, Claims 1-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Blackburn et al.* and *Misura* which is cited in *Blackburn et al.* in view of US. Pat. No. 6,113,813 *Goudjil* and US Pat. No. 4,962,013 *Tateoka et al.*. The deficiencies of the *Blackburn et al.* and *Misura* references have been discussed above and those deficiencies are equally applicable here. Nor do the *Goudjil* or *Tateoka et al.* references make up for these deficiencies.

For example, *Goudjil* discloses three ways of making its film. The first way is by injection molding, the second way is by extrusion molding and the third way is by cell casting. Injection molding and extrusion molding each require the use of heat, and in some circumstances, the heat in those processes will likely degrade the photochromes. Degradation of photochromes would adversely affect the b\* limitation that is recited in the present claims.

Similarly, cell casting requires the use of thermopolymerization initiators and it is known in the art that thermopolymerization initiators also likely lead to degradation or negative implications on the photochromes. And as noted above with respect to injection molding and extrusion molding, this will similarly adversely affect the b\* limitation recited in the claims. Thus it is clear that *Goudjil* does not teach, suggest or

otherwise contemplate a method of making a film that acknowledges the potentially adverse effects that heat-related methods of creating film would have on the degradation of photochromes. And even if a combination of *Goudjil* with *Blackburn* or *Misura* were possible, based on the teachings of *Goudjil*, the resulting product would be away from the claimed invention. Nor does *Takeoka et al.* provide for the deficiencies of *Goudjil* (or for those of *Blackburn* and *Misura*). As a result, it is submitted that the claimed invention is not obvious over the references and the rejection should be withdrawn.

As to claims 2-8, these claims depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

IV. REJECTIONS UNDER 35 USC § 102(B) AS BEING ANTICIPATED BY U.S. PAT. NO. 6,113,813 GOUDJIL

At paragraph 6 of the Office Action, Claims 1-2 and 4-8 were rejected under 35 U.S.C. 102(b) as being anticipated by *Goudjil*. The Examiner asserts that "*Goudjil* discloses the instantly claimed films and laminates, the instantly claimed stabilizer mixtures and the instantly claimed amounts of photochromic compounds." Further, the Examiner asserts that since *Goudjil* "uses the instantly claimed stabilizer combinations, his films must necessarily and inherently possess the instantly claimed improvement in light fatigue and change in b\*."

The deficiencies of the *Goudjil* reference have been discussed above and those deficiencies are equally applicable here. In addition to the above-described deficiencies of *Goudjil*, Applicant asserts that *Goudjil* also fails to disclose or otherwise reference a polyurethane film being sandwiched between an inner and outer protective resin layer, as is recited in the presently amended claims. This is important since placing the presently claimed film between the inner and outer protective resin layers improves light fatigue resistance by minimizing the amount of surface area of the film that contacts the air.

In fact, *Goudjil* does not disclose any improvement in light fatigue resistance or change in  $b^*$  as is recited in the present claims. As was previously argued by Applicant, the processes disclosed in *Goudjil* require use of heat and/or thermopolymerization initiators, and such applications will likely result in degradation or otherwise negative implications on photochromes, which subsequently affects the claimed  $b^*$  units. Therefore, the teaching of *Goudjil* in fact suggests teaching away from the improvement in light fatigue resistance and  $b^*$  limitation that is present in the claims. For at least these reasons, withdrawal of this rejection is respectfully requested.

As to claims 2, 4-6 and 8, these claims depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

V. REJECTIONS UNDER 35 USC §103(A) AS BEING UNPATENTABLE OVER U.S. PAT. NO. 6,113,813 GOUDJIL IN VIEW OF U.S. PAT. NO. 4,962,013 TATEOKA ET AL.

At paragraph 7 of the Office Action, Claims 1-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over US. Pat. No. 6,113,813 *Goudjil* in view of US Pat. No. 4,962,013 *Tateoka et al.*. Specifically, the Examiner asserts that "*Goudjil* discloses the instantly claimed films and laminates, the instantly claimed stabilizer mixtures and the instantly claimed amount of photochromic compounds.

The deficiencies of the *Goudjil* reference have been discussed above and those deficiencies are equally applicable here. Further, neither *Goudjil* nor *Tateoka et al.* disclose any improvement in light fatigue resistance or change in  $b^*$  as is recited in the presently amended claims, and in fact *Goudjil* suggests teaching away from the  $b^*$  limitation of the present claims, as has been previously asserted by Applicant. One of skill in the art would not look to *Goudjil*, either alone or in combination with *Tateoka et al.*, if faced with the task of developing a photochromic polyurethane laminate film with the recited improvement in the light fatigue resistance and change in  $b^*$  of the present claims. Therefore, withdrawal of this rejection is respectfully requested.

Furthermore, claims 2-6 and 8 depend from allowable claim 1 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claim 1. As such, withdrawal of this rejection is respectfully requested.

CONCLUSION

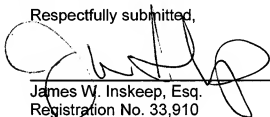
In view of the foregoing, it is demonstrated that none of the prior art cited anticipates or renders obvious, alone or in combination, currently pending claims 1-6 and 8. Thus, it is respectfully requested that the Examiner withdraw all of the rejections and issue a notice of allowance of all claims.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

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